

KINOSHITA, SN 09/855,563
Amendment file 03/04/2005
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REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any other manner indicated below.

PENDING CLAIMS

Claims 11-19 were pending in the application, under consideration and subject to examination at the time of the Office Action. Unrelated to any prior art, scope or rejection, appropriate Claims have been amended, added or deleted in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, the amendments to the claims are unrelated to any prior art or scope adjustment, and are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 11-35 are now pending in the application for consideration and examination.

REJECTION UNDER §112, 2ND PAR. OBVIATED VIA CLAIM AMENDMENT

Claims 11-19 have been rejected under 35 USC §112, second paragraph, as being indefinite for the concerns listed within the sections numbered "2-4" beginning on page 2 of the Office Action. The claims have been carefully reviewed and carefully amended where appropriate in order to address the Office Action listed concerns. Although the Examiner's proposed claims were not adopted in toto, the Examiner is greatly thanked for the effort of proposing claims. As the foregoing is believed to have addressed all §112 second paragraph concerns, reconsideration and withdrawal of the §112 second paragraph rejection are respectfully requested.

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REJECTION UNDER 35 USC §103

The 35 USC §103 rejection of claims 11-19 as being unpatentable over Kawamura (U.S. Patent 4,951,769) in view of "common knowledge in the art" is respectfully traversed. However, such rejections have been rendered obsolete by the present clarifying amendments to Applicant's claims, and accordingly, traversal arguments are not appropriate at this time. However, Applicant respectfully submits the following to preclude renewal of any such rejections against Applicant's clarified claims.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

Applicant's disclosed and claimed invention is directed to a reliable and versatile system having at least two electrical devices, each including an induction motor selectable in real-time to operate as either an electric motor for driving a load and as a generator to generate electric power. For example, Applicant's FIG. 1 shows two electric-motor/generators 10', 10a'. Hence, Applicant's disclosed and claimed invention includes two induction motors. Use of induction motors is advantageous in that specialized DC controls are needed with respect to the same.

Each of the electric-motor/generators 10', 10a' includes a mechanical power source selectably connectable to the induction motor, wherein selectable connection

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is to mechanically drive the induction motor to operate the same as a generator. That is, the electric-motor/generator 10' includes an internal combustion engine 40, and the electric-motor/generator 10a' includes an (e.g., DC) electric motor 11. Such is advantageous in that, if a commercial electrical power is disrupted, and if the FIG. 2 generators 10b, 10c are inoperative, then a still-available opposing mechanical power source (40 or 11) could be used to generate electricity to allow operation of the other electric-motor/generators (10' or 10a') driving a load. For example, the internal combustion engine 40 may drive the electric-motor/generator 10' as a generator to produce electricity, and then the electric-motor/generator 10a' could use that electricity to still drive the compressor 21.

That is, note that each of Applicant's disclosed and claimed electric-motor/generators 10', 10a' are independently operable from each other as either a motor (for driving a load) or a generator (for producing electricity). According, at least three different arrangements could be enabled, *i.e.*, operation as two induction "motors," operation as one induction motor and one generator, and operation as two generators.

Regarding Kawamura, such reference would not have disclosed or suggested Applicant's clarified claims in that Kawamura does not teach use or induction motors (*i.e.*, teaches DC motors), and further, Kawamura's two motors 8 appear to always operate together in tandem as the same type of devices, *i.e.*, as regenerative braking devices. Regarding rejection in the future, Applicant respectfully reminds the Examiner that courts have held that an Examiner cannot make substitutions at will to references in a hindsight attempt to arrive at Applicant's invention. The

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Federal Circuit has stated, "[t]he mere fact that the prior art may be modified in a manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge." The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority: It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In addition to the foregoing, the following additional remarks from Applicant's foreign representative are also submitted in support of traversal of the rejection and patentability of Applicant's claims.

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Kawamura relates to a motor vehicle driving system. The motor vehicle driving system shown in Kawamura is applied to the automobile field. The motor vehicle driving system for the automobile shown in Kawamura has the regenerating means. In the regenerating means shown in Kawamura, the DC motor is employed and then it is necessary to provide controllers.

Some main constructional elements in Applicant's system for generating or utilizing the electrical power are (1) the plural induction motors, (2) each of the plural induction motors is connected to the load, (3) each of the plural Induction motors is connected to the electrical device (the mechanical power source), and (4) the AC electric power line for connecting the plural induction motors.

With the above stated main constructional elements of (1)-(4), the electrical device may be interfaced with an electrical network with a plurality of sensors and controls for changing its operational status from a motor to a generator or vice-versa based on predetermined conditions, for example: when the induction motor is disconnected with the electric device, the induction motor drives to the load; to function the induction motor as the generator, the rotational speed of the electrical device (the mechanical power source) is made more than the synchronous speed of the induction motor; and, when the induction motor is separated from the load and the induction motor presents the free state, the induction motor is operated according to the mechanical power source, thereby the induction motor functions as the generator.

As a result of all of the foregoing, it is respectfully submitted that the applied art (taken alone and in the Office Action combinations) would not support a §103

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obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §103 rejection, and express written allowance of all of the §103 rejected claims, are respectfully requested.

SPECIFIC TRAVERSAL OF "OFFICIAL NOTICE"

Office Action comments in support of the art rejection(s) assert that certain claimed features were well known in the art, *i.e.*, without providing supportive art references for such assertion. With regard to such assertion of apparent judicial (*i.e.*, Examiner) notice of common knowledge or well-known prior art, attention is directed to MPEP §2144.03 which states, "If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Accordingly, in view of Applicant's traversal in this regard, and in accordance with the provisions of MPEP §2144.03, Applicant respectfully requests that a documentary proof be cited to explicitly show that such features were explicitly known in the art, or alternatively, Applicant respectfully requests withdrawal of all rejections based upon such unsupported judicial notice.

EXTENSIVE PROSECUTION NOTED

Applicant and the undersigned respectfully note the extensive prosecution which has been conducted to date with the present application, and thus Applicant and the undersigned would gratefully appreciate any considerations or guidance from the Examiner to help move the present application quickly to allowance.

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RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

An appropriate Petition for extension of time is being filed concurrently herewith. To whatever other extent is actually necessary, Applicant respectfully

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petitions the Commissioner for an extension of time under 37 CFR §1.136. Attached is a Form PTO-2038 authorizing payment of the requisite Petition and claim fees. Please charge any actual deficiency in required fees to ATS&K Deposit Account No. 01-2135 (as Case No. 840.40130X00).

Respectfully submitted,



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Attachments:

Petition for Extension of Time
PTO-2038 (Fee Codes 1202 and 1251)